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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/285,249 | 04/02/1999 | JOHN S. HENDRICKS | 5200 | 3419 |
| 7590 | 04/23/2004 | | EXAMINER | |
| ALDO NOTO Andrews Kurth LLP Suite 300, 1701 Pennsylvania Avenue N.W. WASHINGTON, DC 20006 | | | SLOAN, NATHAN A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2614 | |
| | | | DATE MAILED: 04/23/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/285,249 | HENDRICKS ET AL. |
| | Examiner | Art Unit |
| | Nathan A Sloan | 2614 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 January 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 and 23-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 and 23-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner alerts applicant that there is a new examiner of record. Correspondingly, future communications should be to the present examiner as indicated in the conclusion. A review of the present application particularly with regard to previously presented 112 rejections has been made and these previous grounds of rejection are withdrawn in light of applicants amendments to correct obvious errors regarding a file server transmitting rather than receiving a second authorization code. Where applicant has traversed previous Official Notice statements, reference(s) are now provided and incorporated into the following rejections. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendment to the claims and corresponding arguments asserting allowability.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32

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USPQ2d 1077 (Fed. Cir. 1994). In the present application, applicant has claimed continuation status to PCT/US93/11606 and US application 08/160,194, now patent 5,990,927, which is denied due to separate disclosures. Applicant must correct corresponding deficiencies in claims to priority within the oath / declaration and specification as applicable.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wunderlich et al. (Wunderlich) in view of Farry et al. (Farry) and further in view of Banker (5,357,276).

Considering claim 1, Wunderlich discloses an apparatus for video on demand programs comprising:

- a) a receiver (51) to receive requests for video on demand programs (col. 9, lines 1-3);
- b) a network manager (51) to process said program request (col. 9, lines 4-14);
- c) a file server (52), coupled to the network manager (51), wherein the file server spools the requested program via device (53).

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Although Wunderlich discloses authorizing the subscriber to view the requested program (col. 9, lines 15-20 and 23-26), he fails to specifically disclose an authorization component to transmit a first authorization code to enable set top terminals to receive a requested program, use of a preview channel, and a second authorization code to descramble a scrambled program as recited in the claims.

Farry discloses an apparatus (figure 16) for video on demand programs comprising an authorization component (1670 and/or 501) that transmits a notification signal (e.g. an authorization code or identification) to a level 1 gateway server (1640) for the advantage of authorizing service to a subscriber. See column 11, lines 1-35.

Banker discloses use of a preview channel, transmitting scrambled programs from a headend to set top terminals, and transmitting authorization codes from a system manager to set top terminals for descrambling the scrambled programs. See the entire reference including but not limited to col. 6, lines 54+ through col. 7:3, col. 9:46-48, col. 10:1-16.

It would have been obvious to one of ordinary skill in the art to modify Wunderlich's system (if necessary) to include an authorization component to transmit an authorization code to enable set top terminals to receive a requested program, as taught by Farry, for the typical advantage authorizing service to a subscriber.

Furthermore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Wunderlich and Farry to include use a preview channel as well as a second authorization code to descramble a scrambled program, as taught by Banker, for the additional advantage of conserving bandwidth and descrambling scrambled programs received by set top terminals to prevent theft of program signals.

Claim 2 is met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses a network manager (51) that comprises a processor inherently having an instruction memory for executing the processing of the program request as described at col. 9, lines 4-14.

Claim 3 is met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that group the program requests based on if an on demand channel is available for a given time period. For users that request a channel when all on demand channels are in use, these user requests are grouped by providing users a next open block of time for requesting (col. 9, lines 15-25).

Claims 4-5 are met by the combined systems of Wunderlich, Farry and Banker, wherein Banker discloses time windows for requesting and receiving program requests in association with providing NVOD services in col. 11:2-8, col. 11:23-43, and seen with reference to Figs. 8 and 9 showing time periods for a movie restarting in 9 minutes and the ability to select to receive the requested program. It would have been obvious for one skilled in the art at the time of the invention to modify Wunderlich in view of Farry by utilizing time windows for program requests as taught by Banker in order to enhance NVOD service by providing the subscriber with user friendly features that emulate the VCR functions of pause, fast forward, and rewind (Banker, col. 11:43-46).

Claim 6 is met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65.

Claim 7 is met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses that the request for VOD programs are from set top terminals (14) described throughout the reference including but not limited to col. 5, lines 15-20 and col. 9, lines 1-40.

Claim 8 is met by the combined systems of Wunderlich, Farry, and Banker because the transferring of any signal (including an authorization code) between two equipments has to include an interface device. For example, a printer interface card is necessary in a computer to send data to the printer and an interface is needed in a computer in order to receive input data from a keyboard. Therefore, one of ordinary skill in the art would readily recognize that an interface is a necessary device in the transfer of data between equipments.

Claim 9 is met by the combined systems of Wunderlich, Farry and Banker as described in the rejections of claims 3 and 8.

Claims 10 and 17 are met by the combined systems of Wunderlich and Farry as described in the rejections of claims 3 and 8, since Farry's authorization component (501) has to receive a request in order to issue authorization.

Claim 11 is met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses a network manager (51) that comprises a processor inherently having an instruction memory for executing the processing of the program request as described at col. 9, lines 4-14.

Claim 12 is met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that compile the program requests to determine if a channel is available for a requesting subscriber as described in col. 9, lines 15-25.

Claim 13 is met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses that the request for VOD programs are from set top terminals (14) described through out the reference including but not limited to col. 5, lines 15-20 and col. 9, lines 1-40.

Claims 14-15 are met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses that file server deliver at least one requested program to the requesting subscriber.

Claims 16 and 18-19 are met by the combined systems of Wunderlich, Farry and Banker, wherein Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65. Note that MPEG programs are digital programs.

Claim 20 is met by the combined systems of Wunderlich, Farry and Banker as described in the rejection of claim 1. In particular, the claimed "e) authorizing viewing or delivering of the requested program" is met by the first and/or the second authorization codes and the claimed "f) downloading a second authorization code...." is met by the authorization code taught by Banker. Furthermore, Banker teaches an initial request of an on demand program followed by use of time periods as noted in response to claim 4 and seen in Figs. 8 and 9 showing 9 minutes remaining for a user to provide an additional request. A user may provide this request or choose to wait to a later time, thus authorizing viewing or deliver after the time period (in this case, 9 minutes) expires by using the next channel and a different program block, in this case divided into 15 minute increments. It would have been obvious for one skilled in the art at the time of the invention to modify Wunderlich in view of Farry by utilizing time windows for program requests as taught by Banker in order to enhance NVOD service by providing the subscriber with user friendly features that emulate the VCR functions of pause, fast forward, and rewind (Banker, col. 11:43-46).

As for claim 23, the combined systems of Wunderlich, Farry, and Banker teach use of a preview channel with authorization as taught by Banker in the above noted sections and col. 9:46-48.

As for claim 23, the combined systems of Wunderlich, Farry and Banker disclose all the claimed subject matter as noted above, particularly in response to claim 3.

As for claim 25, the combined systems of Wunderlich, Farry and Banker disclose all the claimed subject matter as noted above, particularly in response to claims 1, 4, and 20.

As for claim 26, the claimed receipt of authorization for a preview channel is met by Banker as noted above in response to claim 20 (particularly col. 9:46-48). It would have been obvious for one skilled in the art at the time of the invention to modify Wunderlich in view of Farry by utilizing a preview channel in order to allow viewers to make assist viewers in making purchasing decisions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703) 305-8143. The examiner can normally be reached on Mon-Fri 7:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703)305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NAS



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